

## REMARKS

### Rejections under section 101

The rejection continues to be traversed. The prior amendments are undone herein.

Applicants have, nevertheless, added that the methods are intended to be executed in a data processing device, which should make clear that the claims fall within the subject matter requirements of the statute. Applicants respectfully submit that this is not a narrowing amendment, because the data processing device was inherent in the way the prior claim was written. Applicants respectfully submit that this should have been better phrased as an objection rather than a rejection, because it relates to a matter of form rather than of substance.

Reconsideration is accordingly respectfully requested.

### Removal of the word "step"

The word "step" has been removed from some of the claims, because some court decisions have attributed unnecessary limitations to such words. This amendment does not narrow the claims.

### Significance of prior official notice

Applicants note the remarks on page 12 of the office action. Applicants respectfully submit that the alleged "official notice" from the prior office action was dependent on the Bridson reference, since the notice also cited that reference. It was in fact a sort of hybrid rejection, stating that certain limitations were obvious from the reference, but calling that "official notice." Since the Bridson reference is overcome, the alleged official notice is mooted. Accordingly, Applicants can and do still challenge the official notice.

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*In addition, since the official notice was based on Bridson and also in view of a rejection of the independent claims over Bridson, the Examiner needs to demonstrate why it is obvious to combine Bridson and the new reference – which the Examiner has not done.*

*Moreover, Applicants have read the section of the MPEP referred to by the Examiner – i.e. 2144.03 -- and find that there is no language about "seasonable" in this section at all. The section does say that the official notice is "taken as admitted" in the next office action, but this does not mean that Applicants can no longer challenge it.*

**Art rejections**

*The art rejections are respectfully traversed.*

*Applicants hereby object to the rejections as being prolix and confusing and therefore not in conformity with 37 CFR 1.104. Huge sections of the reference are quoted without a clear indication of how each one relates to particular recitations of the claims.*

*Rejection of the dependent claims is even more confusing, with many of the claims being grouped together in a single rejection, without any indication of what part of the references allegedly relates to which claim.*

*Clarification is accordingly respectfully requested.*

*Since the reference is complex, Applicants will confine their remarks to those portions of the reference cited by the Examiner, except as otherwise indicated. Applicants make no representation as to the contents of other portions of the reference*

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### Claims 1, 18, & 20

It appears that the Examiner is misconstruing claim 1. The claim recites "obtaining a third party selection history" — in other words, the history of what a third party has selected. Crudely put, this means that in order to build a profile for one user, the claimed method is cribbing from another user's notes.

By contrast, the portions of the reference cited by the Examiner seem to teach building a user profile based on the user's own information, not based on third party selection history.

The claim further recites that the user's profile is updated with items selected from a cluster, which in turn was selected by the user from the third party selection history. The Examiner has not cited any language from the reference that seems at all pertinent to this recitation. He purports to be doing so on page 5 of the office action, but all of the sections cited on page 5 appear to relate to ordering some merchandise. There does not seem to be anything remotely related to updating a user profile, or to selecting a cluster, or to third party selection history.

The Examiner may be implying<sup>1</sup> that the index data base for advertising information in the reference is some kind of third party selection history. Applicants respectfully disagree, since the database is not a history of third party selections, but rather a collection of current recommendations. However, assuming hypothetically that this database is a third party selection history, how is that information used to update the user profile as recited in claim 1? The Examiner has not demonstrated that the reference teaches or suggests this claim limitation.

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<sup>1</sup> Though any such implication is hardly clear

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Moreover, the Examiner indicates without support in the reference that the cluster-related limitations are obvious. The fact that an advertiser provides information to a user fails to teach or suggest that the information is presented in clusters or that the user selects a cluster. The Examiner cites portions of the reference that would allegedly be advantaged by using technology in accordance with the claim recitations, but fails to indicate where the reference teaches or suggests such advantage. The only such teaching or suggestion comes from Applicants' disclosure. Applicants respectfully submit that the Examiner is using impermissible hindsight in reading teachings of Applicants' disclosure in to the reference, when the reference itself fails to teach or suggest the same.

The Examiner also says that the claim is unduly broad. However, the Examiner has failed to produce art which teaches or suggests them. Therefore the claim is not unduly broad.

Applicants accordingly respectfully submit that the Examiner has failed to present a *prima facie* case of obviousness or anticipation against claim 1.

Claims 18 & 20 are believed to be analogous to claim 1, at least with respect to the limitations discussed above.

### Claims 10 & 21

Claims 10 & 21 are very different from claim 1. For instance, claims 10 & 21 do not recite a user profile. The Examiner nevertheless groups them together with claim 1 in the rejections. Applicant respectfully submits that this is improper. In fact, claims 10 & 21 are more similar to claim 19.

Moreover, the Examiner appears to regard the cluster-related limitations of the claims as obvious over the reference without showing any teaching or suggestion in the reference relating

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to such clustering. Applicants respectfully submit that this is impermissible hindsight in light of Applicant's disclosure.

### Official Notices as newly reformulated

Applicants object to the new notices, because it is not clear whether they are rejections over Deidrick or official notices.

Applicants further object to the official notices as failing to distinguish how the recitations of each of the dependent claims are allegedly to be found in the noticed prior art. These are diverse recitations, yet they are all grouped together in a single paragraph as if all the dependent claims recited the same thing. For instance, where does any art teach or select a "k-means clustering routine" per claim 5? Applicants respectfully submit that the rejections of the dependent claims accordingly fail to satisfy 37 CFR 1.104.

With respect to any other art that is allegedly officially noticed by the Examiner, Applicants respectfully request that it be made of record. Without knowing exactly what the Examiner is referring to, it is impossible to determine if that art says what the Examiner alleges or whether that art is combinable with the art of record.

### Claim 19

The Examiner indicates without support in the reference that the cluster-related limitations are obvious. The fact that an advertiser provides information to a user fails to teach or suggest that the information is presented in clusters or that the user selects a cluster. The Examiner cites portions of the reference which would allegedly be advantaged by using

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technology in accordance with the claim recitations, but fails to indicate where the reference teaches or suggests such advantage. The only such teaching comes from Applicants' disclosure. Applicants respectfully submit that the Examiner is using impermissible hindsight in reading teachings of Applicants' disclosure in to the reference, when the reference itself fails to teach or suggest the same.

The Examiner's other rejections and/or points of argument not addressed would appear to be moot in view of the following. Nevertheless, Applicants reserve the right to respond to those rejections and arguments and to advance additional arguments at a later date.

*Please charge any fees other than the issue fee to deposit account 14-1270. Please credit any overpayments to the same account.*

Applicants respectfully submit that they have answered each issue raised by the Examiner and that the application is accordingly in condition for allowance. Allowance is therefore respectfully requested.

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